



Attorney's Docket No.: 09879-003001

3749

*Handwritten initials: JH4 and DM*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Raul Raudales  
Serial No. : 09/293,198  
Filed : April 16, 1999  
Title : VEGETABLE PRODUCT DRYING

Art Unit : 3749  
Examiner : Andrea M. Ragonese

Hon. Commissioner for Patents  
Washington, D.C. 20231

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JAN 16 2003

TECHNOLOGY CENTER R3700

RESPONSE C

Dear Commissioner:

Responsive to the office action dated October 4, 2002, reconsideration of the rejection of claims is respectfully requested in the light of the following remarks and authorities.

3. In what is said to be a printed publication, "Solar-dried Coffee Technology," found on the website www.sunutility.com in June 2000, it is said a description of the invention was disclosed in this country before the invention thereof by the applicant for the patent. An excerpt of the article provided in the 35 U.S.C. §102(a) rejection of the previous office action dated July 3, 2000, is said to reveal that the apparatus of the instant application has been in use and was known by Mesoamerican Development Institute and others in a foreign country since 1994, which is said to be well outside the statutory limitations as stated in 35 U.S.C. §102(a). This reference it is said proves that Applicant and Assignee had prior knowledge of this invention; therefore, Applicant is required to distinguish the invention as claimed over the prior art, including structural details. It is said that proof must be submitted that the invention for the instant application was not known or used by others in this country or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for the patent. Until such distinction is made and/or proof provided to the Examiner, the 102(a)

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CHARLES HIEKEN

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rejection of claims 1-21 and 32-42, as described in the previous office action is repeated and it is said still stands. This ground of rejection is respectfully traversed.

The statutory condition under 35 U.S.C. §102(a) is whether "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent ...." (Emphasis added.)

Manifestly, "Solar-dried Coffee Technology" alleged to be a description of the invention by the Applicant for the patent could not possibly have been known or described before the invention thereof by Applicant. Accordingly, there is no basis for requiring Applicant to prove that the invention for the instant application was not known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by Applicant for the patent, and withdrawal of the rejection of claims 1-21 and 32-42 under 35 U.S.C. §102(a) is respectfully requested.

The initial burden for meeting the conditions for patentability is on the Examiner, see *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984); and a publication by the inventor allegedly disclosing the invention hardly meets that burden that it was known by others before the invention thereof by the Applicant author. If this ground of rejection is repeated, the Examiner is respectfully requested to state the case law upon which she relies in support of the requirement being made for the Applicant to prove that others did not know of the invention before the invention thereof based on a publication by the inventor.

The response we filed to the office action dated July 3, 2000, set forth authorities binding on the Office requiring that in order to sustain a §102 rejection, the single reference relied upon must disclose each and every element in a rejected claim arranged as in a rejected claim, and that the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.

We take this occasion to explain what precedents are considered binding in proceedings in the Patent and Trademark Office (PTO). Where the Court of Appeals for the Federal Circuit has addressed a point of law in a published opinion, the Federal Circuit's decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, i.e., decisions of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. See *South Corp. v. United States*,

690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982)(in banc); *Bar Zell Expeditors, Inc. v. United States*, 698 F.2d 1210, 1211 n. 4 (Fed. Cir. 1983). In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps. *Ex parte Holt*, 19 U.S.P.Q. 2d 1211, 1214 (BPA&I 1991).

The Examiner did not even mention these binding authorities. We said:

The reference does not disclose each and every element in the rejected claims arranged as in the rejected claims. Furthermore, the reference only discloses what the system does, and does not disclose to one skilled in the art how to make the claimed invention work. Accordingly, withdrawal of the rejection of claims 1-21 and 32-42 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to associate each element in each rejected claim with corresponding elements in the reference, quote verbatim the language in the reference regarded as corresponding to each claim element and quote verbatim the language in the reference regarded as a written description disclosing the manner and process of making and using the claimed invention in such full, clear, concise and exact terms as to enable any person skilled in the food product drying art to make and use the claimed invention. Amendment B, p. 5.

The Examiner did not and can not comply with these requests. If this ground of rejection is again repeated, the Examiner is again respectfully requested to associate each element in each rejected claim with corresponding elements in the reference, quote verbatim the language in the reference regarded as corresponding to each claim element in a rejected claim and quote verbatim the language in the reference regarded as a written description disclosing the manner and process of making and using the claimed invention in such full, clear, concise and exact terms as to enable any person skilled in the food product drying art to make and use the claimed invention.

4. It is said that Applicant made the invention known to others in printed publications, "Solar/Biomass Coffee Drying Systems" and "Café Solar<sup>TM</sup>," for a presentation to the Special Coffee Association in this or a foreign country in March 1997. It is said that this disclosure of prior art, as stated in the 35 U.S.C. §102(b) rejection of the previous Office Action proves that the apparatus of the instant application was not only described in a printed publication, but also in public use or on sale in this country for at least 48 months prior to

application for a patent. These references are said to prove that Applicant and Assignee had prior knowledge of this invention; therefore, Applicant is said to be required to distinguish the invention as claimed over the prior art, including structural details. It is said that proof must be submitted that the invention for the instant application was not described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to application of the patent thereof by Applicant for the patent. Until such distinction is made and/or proof provided to the Examiner, the §102(b) rejection of claims 1-21 and 32-42 as described in the previous office action, is said to be hereby repeated and still stands.

In our response to the office action dated July 3, 2000, we said:

Claims 1-21 and 32-42 stand rejected under 35 U.S.C. 102(b) as being unpatentable based upon the printed publications "Solar/Biomass Coffee Drying Systems" and "Café Solar<sup>TM</sup>" said to describe the invention in this country more than one year prior to the date of application for patent in the United States. This ground of rejection is respectfully traversed. Like the website reference, these publications do not disclose each and every element in the claims arranged as in the claims, nor are these references enabling. Accordingly, withdrawal of the rejection of claims 1-21 and 32-42 as anticipated by these publications is respectfully requested. If these grounds of rejection are repeated, the Examiner is respectfully requested to associate each element in each rejected claim with corresponding elements in the references, quote verbatim the language in the references regarded as corresponding to a corresponding element in a rejected claim and quote verbatim the language in each reference regarded as a written description disclosing the manner and process of making and using the invention of each rejected claim, in such full, clear, concise, and exact terms as to enable any person skilled in the food product drying art to make and use the invention of each claim. P. 6.

The Examiner did not and can not comply with this request. If this ground of rejection is again repeated, the Examiner is again respectfully requested to associate each element in each rejected claim with corresponding elements in the references, quote verbatim the language in the references regarded as corresponding to a corresponding element in the references, quote verbatim the language in the references regarded as corresponding to a corresponding element in a rejected claim and quote verbatim the language in each reference regarded as a written description disclosing the manner and process of making and using the invention of each rejected claim in such full, clear, concise and exact terms as to enable any person skilled in the food product drying art to make and use the invention of each claim.

5. The Examiner is said to be requiring from individuals identified under 37 C.F.R. §1.56(c), or any assignee, the submission of such information that is reasonably necessary to properly examine or treat a matter in a pending or abandoned application. The scope of 37 C.F.R. §1.105 is said to be extended to any assignee because the information required may be known to some members of the assignee even if not known by the inventors. The authority for the Office to make such requirements is said to arise from the statutory requirements of examination pursuant to 35 U.S.C. §§131 and 132.

37 C.F.R. §1.105(a)(1) reads as follows:

In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) COMMERCIAL DATABASES:

The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) SEARCH:

Whether a search of the prior art was made, and if so, what was searched.

(iii) RELATED INFORMATION:

A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) INFORMATION USED TO DRAFT APPLICATION:

A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) INFORMATION USED IN INVENTION PROCESS:

A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process,

such as by designing around or providing a solution to accomplish an invention result.

(vi) IMPROVEMENTS:

Where the claimed invention is an improvement, identification of what is being improved.

(vii) IN USE:

Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

The Examiner has not sought any of the information authorized under items (i)-(vii).

As for any other knowledge by others of the invention before the invention thereof by Applicant or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, such information is unknown and/or is not readily available to Applicant or his Assignee.

6. The courtesy of the Examiner in conducting still an additional diligent search is acknowledged with appreciation. The references cited, but not applied, are incapable of functioning as a reference that anticipates, suggests or makes obvious the subject matter as a whole of the invention disclosed and claimed in this application.

The office action did not deal with our repeated traverse of the requirement for restriction. We said:

The traverse of the requirement for restriction is said to be on the grounds that the restriction is proper only if the inventions are independent and distinct. This is said to be not found persuasive because it is said the inventions are distinct if it can be shown that either the process as claimed can be practiced by another materially different process or by hand, or the apparatus as claimed can be used to practice another and materially different process. The Examiner appears to overlook that the statute reads "two or more independent and distinct inventions," not "two or more independent or distinct inventions." The Examiner must show both independence and distinctness in order to support maintaining a requirement for restriction.

Furthermore, the Examiner has not even mentioned the requirement of M.P.E.P. 803 set forth on pages 2-4 of our response directing, "If the search and examination of an entire application can be made without serious burden, the

Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions.”

Accordingly, withdrawal of the requirement for restriction and examination of claims 22-31 on the merits is respectfully requested. If the requirement is repeated, the Examiner is respectfully requested to show why it is proper to treat the conjunction “and” in the statute as “or” and why it involves serious burden to examine claims 22-31 in this application when we have shown there is no serious burden. P. 3.

The Examiner did not and can not comply with our request to show why it is proper to treat the conjunction “and” in the statute as “or” and why it involves serious burden to examine claims 22-31 in this application when we have shown there is no serious burden.

Accordingly, withdrawal of the requirement for restriction and examination of claims 22-31 on the merits is again respectfully requested. If the requirement for restriction is maintained, the Examiner is respectfully requested to show why it is proper to treat the conjunction “and” in the statute as “or” and why it involves serious burden to examine claims 22-31 in this application when we have shown there is no serious burden.

In view of the foregoing authorities, remarks, those previously advanced, and the inability of any prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is still not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps she believes are necessary to place the application in a condition for allowance.

Applicant : Raul Raudales  
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The Commissioner is authorized to apply any other charges or credits to Deposit Account No. 06-1050, Order No. 09879-003001.

Respectfully submitted,

FISH & RICHARDSON P.C.

Date: JAN - 6 2003

  
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Charles Hieken  
Reg. No. 18,411

Fish & Richardson P.C.  
225 Franklin Street  
Boston, Massachusetts 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906  
Attorneys for Application Owner,  
Mesoamerican Development Institute Corp.

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